



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
|-----------------|-------------|----------------------|---------------------|------------------|

10/056,577

01/24/2002

Naohiro Hirose

KON-1707

5337

20311

7590

05/03/2006

LUCAS & MERCANTI, LLP
475 PARK AVENUE SOUTH
15TH FLOOR
NEW YORK, NY 10016

EXAMINER

RODEE, CHRISTOPHER D

ART UNIT

PAPER NUMBER

1756

DATE MAILED: 05/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/056,577

Applicant(s)

HIROSE ET AL.

Examiner

Christopher RoDee

Art Unit

1756

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) 2-5 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 6-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Claims 2-5 remain withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected processes, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 28 August 2003. The basis for the restrictions presented in the Office action of 29 January 2003 remains applicable to the claims. New claims 10 and 11 are examined with the elected invention.

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 6-8, and 10 are rejected under 35 U.S.C. 102(e) as being anticipated by Nozawa *et al.* in US Patent 6,555,281.

This rejection was presented in the last Office action and is extended to new claim 10 for the reasons that follow. In the last Office action the Examiner took the position that the Examples 70 and 71 anticipated the instant claims because this reference appeared to inherently disclose the required number percent of toner particles having a diameter of not less than 0.60 and not more than 1.00 μm . Applicants submitted evidence in the recent response to show that Example 70 does not inherently meet this requirement. However, no evidence was presented for Example 71, which was specifically referenced in the last Office action. As noted there, Example 71's toner has a binder resin and a colorant with SF-1 of 172 and SF-2 of 146. The ratio of SF-1/SF-2 is 1.18. This example has 8.0 number % of particles with a size of 4

Art Unit: 1756

microns or less and an average size of 7.0 microns. This example has even less particles of 4 μm size or less than the tested Example 70.

Because no evidence has been provided for Example 71, this rejection is still seen as proper and is maintained. Applicants have not properly rebutted the Examiner's *prima facie* showing for this example.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 6-8, 10, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nozawa *et al.* in US Patent 6,555,281 in view of Rimai *et al.* in US Patent 4,737,433.

This rejection was presented in the last Office action and is extended to new claims 10 and 11 for the reasons discussed below.

Applicants traverse the rejection because Rimai teaches that its toners should have a generally spherical shape (col. 3, l. 18-20), which equates to a SF-1 value near 100. Since Rimai teaches the spherical shape toner it would not be obvious to combine this reference with Nozawa, which has non-spherical SF-1 values as high as 160. Although applicants note that it may be appropriate to combine Rimai with Nozawa with an SF-1 value at about 100, applicants conclude "no one of skill in the art would take the spherical particles of Rimai and use them with the non-spherical particles in Nozawa, the non-spherical particles being particles having an SF-1 value on the order of 160." Applicants also take the position that, "even if Rimai were combined with Nozawa, a combination would not yield a toner having an SF-1 value in the

Art Unit: 1756

neighborhood of 125 to 170. The reason for this is because Rimai teaches his particles should be spherical...”

The central point throughout applicants' argument is that Rimai is limited in its disclosure to spherical toners. The Examiner cannot agree with this position. The passage relied upon by applicants in column 3 states, “In the process in accordance with this invention, it is preferred that the toner particles be substantially spherical in configuration.” The reference continues, “However, toners falling within the parameters set forth above regardless of their shape may be employed in the process of this invention.” Clearly Rimai's toner is not limited to a spherical shape as asserted by applicants. In fact, Rimai continues in the next paragraph, “The toners employed in the present invention can be prepared by any suitable method of preparation known in the art so long as the finished toner material falls within the parameters set forth above. The polymer material from which the toners are prepared may be polymerized in bulk and then ground by suitable techniques known in the art to achieve a particulate material having substantially the size characteristics desired. Subsequently, classification techniques can be used in order to establish clearly that the toner particles employed in the development process satisfy the 90% and 99% limitations set forth.” The artisan would recognize that a process where toner particles are “ground” from a bulk polymerized mass would not normally produce a spherical toner. Rimai is not limited to spherical toners (i.e., those with SF-1 near 100) as asserted in the response. Nozawa also discloses a grinding (i.e., pulverization) procedure for forming the toner particles in the same manner as Rimai in column 16, lines 51-59. The references clearly suggest toners produced by similar procedures.

Furthermore, Nozawa teaches that the SF-1 values of that invention do also include toners that are spherical or nearly so because SF-1 can be near 100 (col. 14, l. 4-14). As seen in the cited passage, SF-1 can range from the nearly spherical SF-1 = 100 to relatively non-

Art Unit: 1756

spherical particles of SF-1 = 170. Nozawa's disclosure includes the same type of toner particle shapes as Rimai.

Given the exemplified relationships of SF-1 to SF-2 in Nozawa, the artisan would have found it obvious to optimize the SF-1 and SF-2 values to other values near those disclosed, such as in Example 70, in order to obtain the results of the invention.

The rejection is still seen as proper and is maintained.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nozawa *et al.* in US Patent 6,555,281 281 in view of 281 in view of Rimai *et al.* in US Patent 4,737,433 and further in view of Yachi *et al.* in US Patent 5,773,185.

This rejection was presented in the last Office action. No specific reasons for traversal are presented other than those discussed above. Consequently, the rejection is maintained for the same reasons given above.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

Art Unit: 1756

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher RoDee whose telephone number is 571-272-1388. The examiner can normally be reached on most weekdays from 6:00 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on 571-272-1385. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

cdr
1 May 2006


CHRISTOPHER RODEE
PRIMARY EXAMINER